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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,498	08/02/2006	Ronald Rodriguez	59563(71699)	3398

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EXAMINER

GUDIBANDE, SATYANARAYAN R

ART UNIT PAPER NUMBER

1654

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/523,498

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Satyanarayana R. Gudibande

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-11, 14-22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5, 8-11, 14-22, 27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 11 and 14 drawn to a peptide compound selected from the group consisting of SEQ ID NOs: 1-90, 92-107 and a pharmaceutical composition comprising a peptide compound of

Group II, claim(s) 8, drawn to a peptide compound which selectively binds to the extracellular portion of human PSMA and is at least 60% identical to a peptide compound selected from the group consisting of SEQ ID NOs: 1-90, 92-107.

Group III, claim(s) 9, drawn to a peptide compound comprising amino acid residues 2-8 of a peptide compound selected from the group consisting of SEQ ID NOs: 1-90, 92-107.

Group IV, claim(s) 10, drawn to a polypeptide comprising the peptide compound of **Claim 1** and a heterologous peptide. ( The claim has been interpreted to depend from claim1).

Group V, claim(s) 15 and 22, drawn to a method of treating prostate cancer in a subject.

Group VI, claim(s) 16-21 drawn to a method of treating prostate cancer further comprising of a procedure that removes or destroys prostatic tumor tissue,

Group VII, claim(s) 27, drawn to a method of identifying PSMA binding peptides comprising, a) varying at least one amino acid residue of a peptide compound selected from the group consisting of SEQ ID NOs: 1-90, 92-107, b) determining the ability of the peptide to bind to the PSMA.

According to PCT Rule 13.2, unity of invention exists only when the shared or corresponding technical feature is a contribution over the prior art. The inventions listed as Groups I-VII do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature of Group III is drawn to a **peptide compound comprising amino acid residues 2-8 of a peptide compound** selected from the group consisting of SEQ ID NOs: 1-90, 92-107, which is shown by Terada, et al., FEBS Letters, 1978, 90, 89-92. Terada et al., teaches a cyclic peptide CALSYPAQC, the sequence as disclosed comprises of 6 amino acid residues of SEQ ID NO: 5 of the instant application. Therefore, the special technical feature of group III is known in the art and does not make a contribution over the prior art. Therefore, the inventions listed in groups I-VII of the instant application lacks unity of invention and do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Election of Species*

This application contains claims directed to the following patentably distinct species: species of peptide sequences. The species are independent or distinct because they are chemically distinct molecules.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of peptide sequence for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1, 8, 9 and 27 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Claim 10 is generic to the following disclosed patentably distinct species: heterologus peptides. The species are independent or distinct because the peptides are chemically distinct compounds. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of heterologus peptide, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Claim 11 generic to the following disclosed patentably distinct species: therapeutic moiety. The species are independent or distinct because the therapeutic moieties are structurally and chemically distinct molecules. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of therapeutic moiety, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is

Art Unit: 1654

elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

This application contains claims directed to the following patentably distinct species: species of different procedures that removes or destroys prostatic tumor tissue. The species are independent or distinct because they procedures represent distinct treatment methods to treat variety of different cancers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of method of treatment for prostate cancer for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 21 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

### ***Conclusion***

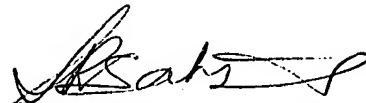
Art Unit: 1654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satyanarayana R. Gudibande whose telephone number is 571-272-8146. The examiner can normally be reached on M-F 8-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**ANISH GUPTA**  
**PRIMARY EXAMINER**

  
Satyanarayana R. Gudibande, Ph.D.  
Art Unit 1654